

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5-14-08 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-25 and 28-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurz et al.(3,451,842) in view of Van Oost(5,931,595).

Kurz et al. discloses methods for manufacturing an impregnated open celled polymeric foamed article wherein a binder solution as claimed is administer and impregnated into the foam through the action of rollers and pressing followed by setting and drying (see the examples, as well as, the entire document). Additionally, shaping, molding, and/or pressing are operations provided for by the teachings of Kurz et al. (see

column 1 lines 60-66). Though not specifically highlighted, the densities of applicants' claims are held to be elements readily envisioned from the disclosed teaching of open celled articles provided for by Kurz et al. Additionally, employment of multiple rollers for purpose of providing the rolling operations disclosed is held to be an operation readily envisioned from the teachings of Kurz et al. based on Kurz et al.'s encompassing disclosure of rolling.

Kurz et al. differs from applicants' claims in that it does not require feeding of the setting slurry through at least one of the rolling apparatuses. However, Van Oost (see the entire document) discloses devices for applying liquid products through perforated rollers for the purpose of providing controlled administration of the applied solution. Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the roller device of Van Oost in applying the binder solution to the open cell article in the preparations of Kurz et al. for the purpose of controlling administration of the binder slurry, providing conservation of administered product, and promoting cleaner administration of the administered material in order to arrive at the processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

The combination of Kurz et al. and Van Oost differs in that perforated multiple rollers are not employed. However, the combination is clear in its disclosure of employment of rollers and administering materials therethrough, and it has been held by the court that the mere duplication of parts has no patentable significance unless a new or unexpected result is produced. (See *In re Harza*, 274 F.2d 669, 124 USPQ 378

Art Unit: 1796

(CCPA 1960), as well as, M.P.E.P. 2144.04 VI. B.) Accordingly, it would have been obvious for one having ordinary skill in the art to have multiplied the perforated roller embodiment provided for by the combination of Kurz et al. and Van Oost in order to arrive at the processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Applicants' latest arguments have been considered. However, rejection is maintained.

The following arguments are maintained:

Applicants' claims do not distinguish over the permeable rollers of the prior art in the patentable sense based on the term "perforated". Both relate to holes for passage of liquid. Applicants' claims further do not distinguish over the prior art based on the degrees of compression defined by the claims. Degrees of compression are not defined by the claims which would distinguish over the degrees identified by the prior art.

As to duplication of the rolling element/effect, it has long been held that duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Unexpected results based on this feature are not seen nor has it been demonstrated.

As to applicants' argument that the secondary teaching is not analogous art, it is held that the determination that a reference is from a non-analogous art is twofold. First, it is decided if the reference is within the field of inventor's endeavor. If it is not, then it must be determined whether the reference is reasonably pertinent to the particular problem with which inventor was involved. *In re Wood*, 202 USPQ 171, 174; *In re Clay*, 23 USPQ.2d 1058. {see also *In re Bigio*, 381 F.3d 1320, 72 USPQ2d 1209 (Fed. Cir. 2004) and M.P.E.P. 2141.01(a)}. The secondary teaching is maintained to be analogous art. Paint is a binder, and the teachings of this secondary teaching are at least reasonably pertinent to the particular problem with which inventor was involved.

Applicants' arguments pertaining to their showings of results have been considered. However, the assertions of results have not been demonstrated in fact and/or shown to be commensurate in scope with the scope of the claims as they currently stand.

Applicants' claims 29-34 have been considered based on the teachings of the combination of the prior art. However, the prior art is seen to provide rollers having a solid core component which is stationary to the degree required by the claims. Feed

conduits are provided by the disclosures of the prior art to the degrees required by the claims as well as the means for delivering the binder to perforated/permeable surface of the roller. Other elements of the new claims are addressed in the arguments above.

Rejection does not fail because of the failures of the testing indicated in applicants' reply. These failed tests do not substitute for the required commensurate in scope showing of new or unexpected results attributable to differences in applicants' claims. Additionally, applicants' assertion of effects associated with their process operations does not substitute for a fact based showing of new or unexpected results attributable to differences in applicants' claims.

As to the make-up of the permeable cylinder of the secondary teaching, it is held and maintained that this permeable cylinder is a perforated roller to the degree required by applicants' claims.

Distinction in applicants' invention based on the meaning of the low viscosity paint of Van Oost versus the slurry of Kurz et al. is not seen. From the standpoint of patentability, Van Oost provides means for administering flowable material which is properly combined with Kurz et al. Distinction in terminology used in defining the flowable materials is not sufficient demonstration of the failure of these combined teachings. The combinations of the above prior art are maintained to be properly combined and analogous art for the reasons set forth above.

That the teaching of Van Oost may have other value, such as uniformly distributing the flowable mixture on the roller, does not negate its applicability in the combination set forth above. Additionally, it is the primary reference that identifies

Art Unit: 1796

impregnating the rolled article, this is not a feature lacking from the primary, Kurz et al., teaching.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Cooney/

Primary Examiner, Art Unit 1796